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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,746	10/18/2000	Keith David Bussell	40624/RRT/S850	7076

23363 7590 03/11/2003

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EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,746

Applicant(s)

BUSSELL, KEITH DAVID

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

This is in response to a letter for patent filed on October 18th, 2000 in which claims 1-51 are presented for examination. Claims 1-51 are pending in the letter.

Claim Objections

1. Claims 6-8, 12, 14, 16-18 are objected to because of the following informalities: applicants disclose "*the cryptographic module*". Applicants are advised to delete the "*the*" in order to overcome examiner's objection.
2. Claims 7 and 17 are objected to because of the following informalities: applicants disclose "*the proper operation*". Applicants are advised to delete the "*the*" in order to overcome examiner's objection.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

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filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 16-18 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 6-8. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

5. Applicant is advised that should claims 6-8 be found allowable, claims 16-18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (U.S. Patent No 6,005,945 (*Applicant admitted prior art*) in view of Heiden (U.S. Patent No. 6,408,286).

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8. As per claim 1, Whitehouse teaches an on-line system for printing a value-bearing item (VBI) (*electronic distribution of postage, 100*) comprising a plurality of user (*customer, 104*) terminals coupled to a computer network (*network, fig 3*), and a cryptographic device (*secure central computer 102, memory 154*) remote from the plurality of user terminals and coupled to the computer network (*see figs 3, 4, column 7 line 54-8 line 11*), wherein the cryptographic device includes a computer executable code for verifying that the advertisement graphics is authorized to be printed next to the VBI (*see figs 3, 4, column 8 line 59-65, 9 line 12-50*).

Whitehouse fails to teach a digitally signed advertisement graphics to be printed next to the VBI. However, Heiden teaches a digitally signed advertisement graphics to be printed next to the VBI (*see abstract, figs 2, 3, column 5 lines 35-51*). Therefore, it would have been obvious to one of skill in the art at the time the invention was made to modify Whitehouse's inventive concept to include Heiden's a digitally signed advertisement graphics to be printed next to the VBI because this would have allowed advertisers to take advantage of the space on the outgoing envelopes for a particular postage meter user to advertise products and/or services thereby providing an effective manner for advertisers to reach their target audience and providing economic incentive for third parties advertisers postage meter users to participate.

9. As per claim 2, Whitehouse teaches a system wherein the cryptographic device includes a computer executable code for verifying the advertisement graphics using a DSA algorithm, a public key, and a previously assigned digital signature (*see column 8 line 38-43, 9 line 51-63, 13 line 46-65*).

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10. As per claim 3, Whitehouse teaches a system wherein the computer executable code verifies if the digitally signed advertisement graphics has a correct digital signature file (*see column 8 line 38-43, 9 line 51-63, 13 line 46-65*).

11. As per claims 4 and 5, Whitehouse teaches a system further comprising computer executable code for tracking a usage of the VBI including one or more of number of users signed up for the on-line system, number of users who have purchased at least a predetermined amount of VBI, number of users who have printed at least a predetermined amount of VBI, and number, of users who have maintained an account for a minimum number of predetermined period (*see column 4 line 59-5 line 2, 10 line 45-11 line 29*).

12. As per claim 6, 16, Whitehouse teaches a system wherein the cryptographic module includes a computer executable code for preventing unauthorized modification of data (*see column 15 line 1-17*).

13. As per claim 7, 17, Whitehouse teaches a system wherein the cryptographic module includes a computer executable code for ensuring the proper operation of cryptographic security and VBI related meter functions (*see column 5 line 3-17*).

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14. As per claim 8, 18, Whitehouse teaches a system wherein the cryptographic module includes a computer executable code for supporting multiple concurrent users (*see fig 3, 4, and 7*).
15. As per claim 9, Whitehouse teaches a system further comprising a database remote from the plurality of user terminals including information about the users (*see column 8 line 54-63*).
16. As per claim 10, Whitehouse teaches a system further comprising a plurality of security device transaction data stored in the database for ensuring authenticity of the one or more users, wherein each security device transaction data can be processed in the server system in a stateless manner (*see column 9 lines 32-63*).
17. As per claim 11, Whitehouse teaches a system wherein each security device transaction data is related to a user (*see column 9 line 12-31*).
18. As per claim 12, Whitehouse teaches a system wherein the security device transaction data related to a user is loaded into the cryptographic module wiper the user requests the operate on a value bearing item (*see column 9 lines 32-63*).
19. As per claim 13, Whitehouse teaches a system wherein the security device transaction data related to a user is updated and returned to the database (*see column 9 lines 32-63*).

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20. As per claim 14, Whitehouse teaches a system wherein the cryptographic module performs cryptographic function on a transaction related to the database (*see column 9 lines 32-63*).

21. As per claim 15, Whitehouse teaches a system further comprising computer executable code for password authentication to prevent unauthorized access to the database (*see column 12 line 16-26, 57-64*).

22. As per claim 19, Whitehouse teaches a system wherein the database includes one or more indicium data elements, data for account maintenance, and data for revenue protection (*see fig 1*).

23. As per claims 20 and 21, Whitehouse teaches a system wherein the database includes virtual meter information, descending register data (*see column 13 line 20-45, 14 lines 25-36, 16 line 19-38*).

24. As per claims 22-28, Whitehouse teaches a system wherein a bar code is printed on the value bearing item that is a mail piece with a digital signature, is a ticket, is a coupon, is currency, is a voucher (*see column 7 line 46-53, 8 line 14-18, 13 lines 56-60*).

25. As per claim 29, Whitehouse teaches a method for printing an advertisement next to a value bearing item (VBI) (*electronic distribution of postage, 100*) via a communication network

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(*network, fig 3*) including a client system (*host system, fig 3*), and a server system (*secure central computer 102, memory 154*) (*see figs 3, 4, column 7 line 54-8 line 11*) comprising interfacing (*communicating*) with one or more users (*customer, 104*) via the client system (*host system, fig 3*), (*see figs 3, 4, column 7 line 54-8 line 11*) communicating with the client system over the communication network , and verifying the digitally signed advertisement graphics using a cryptographic module (*see abstract, and figs 3, 4 and 7*). Whitehouse fails to teach a digitally signed advertisement graphics to be printed next to the VBI. However, Heiden teaches a digitally signed advertisement graphics to be printed next to the VBI (*see abstract, figs 2, 3, column 5 lines 35-51*). Therefore, it would have been obvious to one of skill in the art at the time the invention was made to modify Whitehouse's inventive concept to include Heiden's a digitally signed advertisement graphics to be printed next to the VBI because this would have allowed advertisers to take advantage of the space on the outgoing envelopes for a particular postage meter user to advertise products and/or services thereby providing an effective manner for advertisers to reach their target audience and providing economic incentive for third parties advertisers postage meter users to participate.

26. As per claim 30, Whitehouse teaches a method of verifying the advertisement graphics using a DSA algorithm, a public key, and a previously assigned digital signature (*see column 9 line 32-63, 16 line 19-67*).

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27. As per claim 31, Whitehouse teaches a method verifying if the digitally signed advertisement graphics has a correct digital signature file (*see column 9 line 32-63, 16 line 19-67*).
28. As per claim 32, 33, Whitehouse teaches a method further comprising tracking a usage of the VBI including one or more of number of users signed up for the on-line system, number of users who have purchased at least a predetermined amount of VBI, number of users who have printed at least a predetermined amount of VBI, and number, of users who have maintained an account for a minimum number of predetermined period (*see column 4 line 59-5 line 2, 10 line 45-11 line 29*).
29. As per claim 34, Whitehouse teaches a method further comprising preventing unauthorized modification of data (*see column 15 line 1-17*).
30. As per claim 35, Whitehouse teaches a method further comprising ensuring the proper operation of cryptographic security and VBI related meter functions (*see column 5 line 3-17*).
31. As per claim 36, Whitehouse teaches a method further comprising supporting multiple concurrent users (*see figs 3, 4 and 7*).
32. As per claim 37, Whitehouse teaches a method further comprising including information about the users in a database remote from the plurality of user terminals (*see figs 3, 4 and 7*).

33. As per claim 38, Whitehouse teaches a method further comprising storing in the database a plurality of security device transaction data for ensuring authenticity of the one or more users, wherein each security device transaction data is processed in the server system in a stateless manner (*see column 9 lines 32-63*).

34. As per claim 39, Whitehouse teaches a method wherein each security device transaction data is related to a user (*see column 9 line 12-31*).

35. As per claim 40, Whitehouse teaches a method further comprising loading the security device transaction data related to a user into the cryptographic module when the user requests to operate on a value bearing item (*see column 5 line 3-17*).

36. As per claim 41, Whitehouse teaches a method further comprising preventing unauthorized modification of data using the cryptographic module (*see column 15 line 1-17*).

37. As per claim 42, Whitehouse teaches a method further comprising storing data for creating one or more indicium, account maintenance, and revenue protection (*see fig 1*).

38. As per claim 43-46, Whitehouse teaches a method further comprising printing a mail piece includes a digital signature, a postage amount, an ascending register of used postage and

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descending register of available postage (*see column 13 lines 20-40, 14 line 25-36, 16 lines 19-38*).

39. As per claim 47-51, Whitehouse teaches a method further comprising printing a ticket, printing a bar code, printing a coupon, currency, a voucher (*see column 7 line 46-53, 8 line 14-18, 13 lines 56-60*).

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. *Cordey et al (U.S. Patent No. 6,466,921) teach a virtual postage metering system provides central management of all postage without the need to manage physical meters or PSDs*

b. *Amanda (U.S. Patent No 6,385,731)) teaches on-line electronic postage metering system that operates in conjunction with the United States Postal Service (USPS) that allows a user to print a postal indicium at home, at office, or any other desired place in a secure and fraud-free manner. A user computer and a user printer, electronically connected to the PSD server and the USPS computer, constitute an on-line electronic postage meter.*

c. *Kara et al (U.S. Patent No. 6,249,777) teach a demand program that may be coupled to a word processing program, or other process, residing within the first PC,*

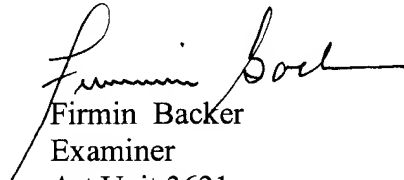
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thus allowing the user to request and subsequently print the postage indicia on correspondence or postal items generated by the coupled process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
Art Unit 3621

March 3, 2003